

MARK D. SELWYN (CA SBN 244180)  
mark.selwyn@wilmerhale.com  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
2600 El Camino Real, Suite 400  
Palo Alto, California 94306  
Telephone: (650) 858-6000  
Facsimile: (650) 858-6100

CATHERINE M.A. CARROLL (*pro hac vice*)  
catherine.carroll@wilmerhale.com  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
1875 Pennsylvania Avenue NW  
Washington, DC 20006  
Telephone: (202) 663-6000  
Facsimile: (202) 663-6363

*Attorneys for Plaintiffs Apple Inc., Cisco  
Systems, Inc., and Intel Corporation*

DANIEL T. SHVODIAN (CA SBN 184576)  
DShvodian@perkinscoie.com  
PERKINS COIE LLP  
3150 Porter Drive  
Palo Alto, CA 94304  
Telephone: (650) 838-4300  
Facsimile: (650) 737-5461

*Attorney for Plaintiff Google LLC*

JOHN B. SGANGA (CA SBN 116211)  
John.Sganga@knobbe.com  
KNOBBE MARTENS OLSON & BEAR  
LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614  
Telephone: (949) 760-0404  
Facsimile: (949) 760-9502

*Attorney for Plaintiffs Edwards Lifesciences  
Corporation and Edwards Lifesciences LLC*

*A complete list of parties and counsel  
appears on the signature page per Local Rule  
3-4(a)(1)*

**UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

APPLE INC., CISCO SYSTEMS, INC.,  
GOOGLE LLC, INTEL CORPORATION,  
EDWARDS LIFESCIENCES  
CORPORATION, and EDWARDS  
LIFESCIENCES LLC,

Plaintiffs,

v.

ANDREI IANCU, in his official capacity as  
Under Secretary of Commerce for Intellectual  
Property and Director, United States Patent and  
Trademark Office,

Defendant.

Case No. 20-cv-6128-EJD

**PLAINTIFFS' RESPONSE TO  
DEFENDANT'S NOTICE OF  
SUPPLEMENTAL AUTHORITY**

Date: Under Submission

Judge: Hon. Edward J. Davila

1 The Federal Circuit’s decision in *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*,  
 2 No. 21-1071 (Fed. Cir. Mar. 12, 2021), is irrelevant to this action for three reasons:

3 First, *Mylan* addresses the Federal Circuit’s jurisdiction to review a decision to deny an IPR  
 4 petition (whether by appeal or by mandamus), but Plaintiffs do not seek review of a specific  
 5 institution decision on a particular IPR petition; therefore neither § 314(d) nor the standards  
 6 governing mandamus apply here. *See* MTD Opp. 18-19.

7 Second, *Mylan* discusses the Director’s discretion to deny IPR petitions, slip op. at 6, 11-12,  
 8 but Plaintiffs do not dispute that the Director has discretion to deny otherwise-eligible petitions.  
 9 Rather, Plaintiffs contend that the Director cannot exercise that discretion in a manner that  
 10 contravenes the America Invents Act (“AIA”) or the Administrative Procedure Act (“APA”), and  
 11 *Mylan* nowhere addresses that issue or embraces the Director’s contrary position. *Mylan* cites  
 12 *Heckler v. Chaney*, 470 U.S. 821 (1985), but does not purport to disagree with *Heckler*’s  
 13 recognition—pertinent here—that even when taking an act otherwise committed to their discretion by  
 14 law, agencies are not “free to disregard legislative direction in the statutory scheme that the agency  
 15 administers,” *id.* at 833. Nor does *Mylan* suggest that “administrative efficiency” immunizes an  
 16 arbitrary and unreasoned rule that contravenes the AIA and APA from judicial review.

17 Third, *Mylan* does not discuss the test for reviewability under § 701(a)(2) or disturb the  
 18 settled proposition that § 701(a)(2) does not even apply to a claim that an agency adopted a rule in  
 19 violation of the APA’s notice-and-comment requirements, a point the Director does not dispute. *See*  
 20 MTD Opp. 21.

21  
 22 Dated: March 15, 2021

Respectfully submitted,

23 By: /s/ Mark D. Selwyn

24 MARK D. SELWYN (CA SBN 244180)  
 25 mark.selwyn@wilmerhale.com  
 26 WILMER CUTLER PICKERING  
 27 HALE AND DORR LLP  
 28 2600 El Camino Real, Suite 400  
 Palo Alto, California 94306  
 Telephone: (650) 858-6000

Facsimile: (650) 858-6100

CATHERINE M.A. CARROLL (*pro hac vice*)  
DAVID M. LEHN (*pro hac vice*)  
REBECCA LEE (*pro hac vice*)  
catherine.carroll@wilmerhale.com  
david.lehn@wilmerhale.com  
rebecca.lee@wilmerhale.com  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
1875 Pennsylvania Avenue NW  
Washington, DC 20006  
Telephone: (202) 663-6000  
Facsimile: (202) 663-6363

ALYSON ZUREICK (*pro hac vice*)  
alyson.zureick@wilmerhale.com  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
7 World Trade Center  
250 Greenwich Street  
New York, NY 10007  
Telephone: (212) 230-8800  
Facsimile: (212) 230-8888

*Attorneys for Plaintiffs Apple Inc., Cisco  
Systems, Inc., and Intel Corporation*

DANIEL T. SHVODIAN (CA SBN 184576)  
DShvodian@perkinscoie.com  
PERKINS COIE LLP  
3150 Porter Drive  
Palo Alto, CA 94304  
Telephone: (650) 838-4300  
Facsimile: (650) 737-5461

1 THERESA NGUYEN (CA SBN 284581)  
2 RNguyen@perkinscoie.com  
3 PERKINS COIE LLP  
4 1201 Third Avenue, Suite 4900  
5 Seattle, WA 98101  
6 Telephone: (206) 359-6068  
7 Facsimile: (206) 359-9000

8 ANDREW T. DUFRESNE (*pro hac vice*)  
9 ADufresne@perkinscoie.com  
10 PERKINS COIE LLP  
11 33 East Main Street, Suite 201  
12 Madison, WI 53703  
13 Telephone: (608) 663-7492  
14 Facsimile: (608) 663-7499

15 *Attorneys for Plaintiff Google LLC*

16 JOHN B. SGANGA (CA SBN 116211)  
17 CHRISTY G. LEA (CA SBN 212060)  
18 John.Sganga@knobbe.com  
19 Christy.Lea@knobbe.com  
20 KNOBBE MARTENS OLSON & BEAR LLP  
21 2040 Main Street, 14th Floor  
22 Irvine, CA 92614  
23 Telephone: (949) 760-0404  
24 Facsimile: (949) 760-9502

25 *Attorneys for Plaintiff Edwards Lifesciences*  
26 *Corporation and Edwards Lifesciences LLC*  
27  
28

1 ATTORNEY ATTESTATION

2 I, Mark D. Selwyn, am the ECF User whose ID and password are being used to file this document. In  
3 compliance with N.D. Cal. Civil L.R. 5-1(i)(3), I hereby attest that concurrence in the filing of the  
4 document has been obtained from each of the other signatories.

5 By: /s/ Mark D. Selwyn  
6 Mark D. Selwyn  
7

8 CERTIFICATE OF SERVICE

9 I hereby certify that on March 15, 2021, I electronically filed the above document with the  
10 Clerk of the Court using CM/ECF which will send electronic notification of such filing to all  
11 registered counsel.

12 By: /s/ Mark D. Selwyn  
13 Mark D. Selwyn  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28